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APP 19 2001

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In re Application of	:
Andrei Gonioukh et al	:
Serial No.: 10/070,860	: PETITION DECISION
Filed: March 12, 2002	:
Attorney Docket No.: 50734	:

This is in response to the petition under 37 CFR 1.144, filed November 20, 2003, requesting withdrawal of an improper restriction requirement. The delay in acting on this petition is regretted, but was occasioned by scanning requirements and Office moves.

## BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on March 12, 2002, and contained claims 15-28, claims 1-14 having been canceled. In a first Office action, mailed June 2, 2003, the examiner set forth a Lack of Unity requirement in accordance with PCT Rule 13.1 and 13.2 and 37 CFR 1.499, as follows:

Group I – Claims 15-18, drawn to compounds of formula 1 where R1 and R2 form pyrrole rings;

Group II – Claim 19, drawn to a method of preparing symmetrical compounds of formula 1 where R1 and R2 are triazole rings;

Group III – Claim 20, drawn to a process of preparing unsymmetrical compounds of formula 1 where R1 is a pyrrole and R2 is a large heterocycle;

Group IV – claims 21-23, drawn to a compound of formula VI and process of making where R1 and R2 are pyrrole rings; and

Group V – claims 24-28, drawn to a process for preparing olefins using the compounds of formula VI.

The examiner indicated that Group II or Group III would be rejoined with Group I upon election thereof. The examiner reasoned that the compounds lack unity in that they do not contain a common special technical feature, as required, which defines over the art. It is to be noted that all dependent claims presented in the preliminary amendment improperly depend from canceled claims.

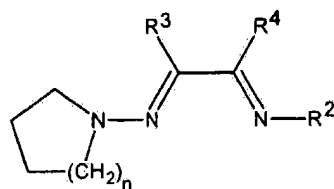
Applicants replied on July 3, 2003, electing Group IV with traverse, specifically requesting that Group V be rejoined with Group IV, and vigorously traversing the requirement based on the guidelines set forth in the PCT Administrative Instructions and Annex B.

The examiner mailed a non-Final Office action to applicants on August 13, 2003, acknowledging applicants' election of Group IV and traversal. The examiner maintained the Lack of Unity holding based on lack of a common significant special technical feature, but defined the concept of R1 and R2 to be considered. Claims 21-23 were then objected to as containing non-elected subject matter and the other claims held as non-elected.

Applicants replied on November 24, 2003, by correcting the dependency of all claims and making other minor amendments and adding claims 29-31. Concurrently this petition of the Lack of Unity requirement was also presented. Although the requirement has not been made Final, it is a repeated action of the examiner and therefor reviewable by petition.

## DISCUSSION

The compounds of Groups I-III defined by the claims are diimines in which an NR5R6 is bonded to one or both of the terminal nitrogen atoms of the diimine. NR5R6 is defined, *inter alia*, as a 5-7 membered ring including the N through which it is attached to the nitrogen diimine. Groups IV and V are directed to metal complexed diimines of Groups I-III. Applicants argue that under Lack of Unity standards the common special technical feature of all the compounds is:



This is essentially correct except that  $R^2$ ,  $R^3$  and  $R^4$  are variable and are thus not a part of the common special technical feature. The question then arises whether this structure makes a contribution over the prior art. If it does then Unity exists. However, if it does not then Unity based on this structure does not exist. The examiner has made no showing that this structure does not make a contribution over the art and therefore cannot be used as a basis for Unity of Invention. Should the examiner make such a showing based on art of record, a larger structure, such as that currently defined by the examiner, may be a basis for Unity of some of the structures encompassed by the claims. With a Markush group, such as this, multiple unrelated structures may establish Unity for a limited number of compounds. Applicants' reference to Example 18 of the PCT Annex B (in effect prior to January 1, 2004) uses a commonly known indolyl fused ring structure to illustrate how Unity or lack thereof is determinable. Presumed is that the indolyl structure itself makes a contribution over the art. If all compounds have such a structure and possess the same utility they are considered to have Unity. However the example is illustrative only and should not be read as making a statement that any common or known structural element provides a basis for unity when common utility exists.

Inasmuch as this application conforms to PCT practice, compounds and their method of use are considered to have Unity, so long as the compounds make a contribution over the art. As such, Groups IV (compounds) and Group V (method of use of the compounds) are considered to have Unity based on the finding that the compounds indicated by the examiner avoid the prior art. This may not be valid for all compounds, however.

Applicants also argue that the compounds of Group I are intermediates to the compounds of Group IV. Based on the common structural feature identified by applicants this is so and these groups should be considered together as having Unity. However the fact that there are different methods of making the compounds of Group I is an indicator that Unity does not exist between Group I and Groups II and III.

#### DECISION

The petition is **GRANTED** to the extent that Lack of Unity will be reconsidered by the examiner with respect to Groups I, IV and V as set forth.

**The application will be forwarded to the examiner for further action not inconsistent with this decision which will include consideration of Unity based on the smallest common technical feature shown above. Should this not provide a basis for Unity, other more involved structures will be considered as a basis for Unity or multiple findings of Unity among compounds.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.



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